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V6

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/426,011	10/25/99	SIMONS	M BIS-043/CIP
		HM22/1220	EXAMINER MOEZIE, F
			ART UNIT 1653
			PAPER NUMBER 9
<b>DATE MAILED:</b> 12/20/00			

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<i>file</i> <b>Office Action Summary</b>	Application No. <b>09/426,011</b>	Applicant(s) <b>Simons</b>
	Examiner <b>F. T. Moezie</b>	Group Art Unit <b>1653</b>

Responsive to communication(s) filed on 10/25/99 and 09/18/00

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-14 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **DETAILED ACTION**

### **CLAIMS STATUS**

Claims 1-14 are pending in this application.

### **OBJECTION - SPECIFICATION**

The specification is found objectionable regarding the content of pages 13, Flow Scheme A (would have to be presented as a figure); Table 3 (would have to be presented as a figure) and page 28 - table 4 (would have to be deleted and the proper SEQ ID NO entered in the specification following the related amino acid sequence). Applicant has already complied with the amino acid Sequence Listing Requirements in the specification and the Listings have been approved by the Office and entered.

However, compliance with the Amino Acid Sequence Requirement is incomplete for the following reasons;

**Note: Upon compliance with the requirements applicant must also amend the application to provide the SEQ ID NOS in THE SPECIFICATION (at least in the first occurrence), in ALL EXAMPLES, TABLES, and THE CLAIMS.**

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The abbreviations entered in the specification must be defined (at least in the first occurrence) for clarity, for example, "PR-39 peptides" at page 2 and claim 1; IxB ; in claim 9 and HIF in claim 10 are not defined.

### **CLAIM REJECTION - 35 USC 112, SECOND PARAGRAPH**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are vague and indefinite as to how steps (a) to © of claims 1 and 2 are monitored. Additionally, in claims 9 and 10, the claims are indefinite and unclear as to how the degradation of IxB or HIF-<sup>Q</sup> is selectively inhibited and how such degradations are monitored.

### **REJECTION - 35 USC 102 (b)/103 (a)**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent No. 5,654,273 to Gallo et al., issued 05 August 1997.

The document discloses that a method for treating angiogenesis using PR-39 is known in the art. See, the entire document, especially the abstract and examples. Because the claims are drawn to a method of using a known peptide for treating a condition taught by the art, regardless of the mechanism of action, the claims are inherently anticipated and/or rendered obvious by the art.

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Claims 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallo et al., US Patent No. 5,654,273.

The reference discloses a peptide comprising the sequences of the peptides as claimed. See, the entire document and the sequence listing. Hence, the claims are anticipated by the art.

No claim is allowed.

Any inquiry concerning this communication should be directed to F.T. Moezie at telephone number (703) 305-4508 or Mr. LOW (SPE) at 308-2923.

J.J. Moezie  
MARY EXAMINER  
ART UNIT 1653